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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/797,508

03/10/2004

Michael Pang-Cheng Hsu

884.367US3

4011

21186

7590

09/30/2004

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. BOX 2938

MINNEAPOLIS, MN 55402

EXAMINER

CUNNINGHAM, TERRY D

ART UNIT

PAPER NUMBER

2816

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/797,508

Applicant(s)

HSU ET AL.

Examiner

Terry D. Cunningham

Art Unit

2816

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 7-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 03/10/04.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Abstract

The abstract is objected to as discussed the non-elected invention. Appropriate correction is required. The Abstract is general enough to cover all embodiments of the invention. The Abstract should be limited to the claimed embodiment of the invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 7-26 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 26-37 of copending Application No. 10/146,689. Although the conflicting claims are not identical, they are not patentably distinct from each other

because the specificity of the claims necessarily anticipates the claim language of the instant invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-11 and 17-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soyner (USPN 5,422,603) in view of Matsui (USPN 6,300,803). Soyner discloses, in Fig. 1, a circuit comprising: “voltage controlled oscillator (100)”; and “a phase detector (300)”.

However, the reference to Soyner fails to disclose any specific details for the broad “phase detector” 300. The reference to Matsui discloses, in Fig. 8, a specific phase detector comprising “a sampling circuits (Q11 and Q12)” and a “linear voltage-to-current converter” having “a first transconductance amplifier (Q1, Q2, Q7, Q8 and Q16)”; and “a second transconductance amplifier (Q3-Q5, Q9, Q10, Q13, Q14 and Q17)”; and “an output stages (Q6 and Q15)”. This phase detector is disclosed as having the advantage of offset compensation. Therefore, it would have been obvious for one skilled in the art to use the specific phase detector circuit of Matsui for the broad phase detector 300 of Soyner for the expected advantage of offset compensation.

Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishikawa (USPN 5,748,018) in view of Soyner and Matsui. Ishikawa discloses, in Figs. 1C and 3A, a circuit comprising: “a phase lock loop (613)”; and “a plurality of sequential elements (100 and

200)". The reference to Ishikawa does not expressly disclose the details of the PLL circuit. The above discussed combination of Soyner and Matsui provides a circuit having offset compensation". Therefore, it would have been obvious to use the specific PLL in the above combination to Soyner and Matsui for the broad PLL 613 in the reference to Ishikawa to obtain the expected advantage of offset compensation therein.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terry Cunningham whose telephone number is 703-308-4872. The examiner can normally be reached on Monday-Thursday from 7:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy P. Callahan can be reached on 703-308-4876. The fax phone numbers for Technology Center 2800 are 703-872-9318 for Before Final communications and (703) 872-9306 for After Final communications. Please note, any faxed paper clearly stating **DRAFT** or **PROPOSED AMENDMENT** at the top will be forwarded directly to the Examiner. All others will be treated as a formal response and acted upon accordingly.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 703-308-0956.

TC
September 27, 2004


Terry D. Cunningham
Primary Examiner
Art Unit 2816